

REMARKS**Amendments to the claims:**

Claims 30, 32-33, 35, 39 and 40-41 are hereby amended; claims 36-38 are hereby cancelled. Specifically:

- Independent claims 30, 35 and 41 have been amended to include additional limitations. Support for these additional limitations can be found in the original specification at ¶¶ [0026] and [0045], and Fig. 3, steps 306 and 308;
- Dependent claims 32 and 33 have been amended to be consistent with the amendments to independent claim 30, from which claims 32 and 33 depend;
- Dependent claims 36-38 are hereby cancelled (without prejudice to presenting these claims again at a later date) as being redundant and/or inconsistent with the amendments to claim 35, from which claims 36-38 originally depended; and
- Dependent claims 39 and 40 have been amended to be consistent with the amendments to independent claim 35, from which claims 39 and 40 depend.

No new matter has been added to the claims by way of the above amendments.

Rejection of claim 30 under 35 USC § 112:

Claim 30 has been rejected under 35 USC § 112, second paragraph, for "failing to specifically point out and set forth what the applicant regards to be his invention". (See Office action date April 4, 2007, page 3.) Specifically, the Examiner contends:

The fourth clause, "logic for" seems to invoke 35 USC 112 sixth paragraph as set forth in *Massachusetts Institute of Technology v. Abacus Software*, 80 USPQ2d 1225 (Fed. Cir. 2006), given that "logic for" is 'a generic structural term that, standing alone, is synonymous with "means" and connotes no more structure than "means," (cf. 1231-1232), and it is not proceeded by any other terminology. Such element is therefore rejected under 35 USC 112, second paragraph, for failing to expressly point out what elements constitute the recited 'logic for,' which corresponds to 'means'.

(See Office action date April 4, 2007, page 3.)

The Applicant contends that, in view of the current amendments to claim 30, the rejection of claim 30 under 35 USC § 112, second paragraph, is now moot. Specifically:

Claim 30 has been amended to replace the previous language of “logic for providing ...” with the new language, “logic configured to provide” Support for this amendment is found in the original specification at least at ¶ [0026]. Since claim 30 now (as currently amended) no longer invokes a “means for” clause (or its equivalent), but now recites specific functional requirements, the Applicant contends that the rejection of claim 30 under 35 USC 112 is now moot, and requests that this rejection of claim 30 be removed.

Rejection of claims under 35 USC § 103(a)

Claims 30-41 have been rejected under 35 USC § 103(a) as being obvious over U.S. Published Pat. App. No. 2003/0133025 (“Ojima”) in view of U.S. Published Pat. App. No. 2005/0146616 (“Parulski”).

The Applicant contends that claims 30-41, as amended herein, are not obvious over the cited references, for at least the following reasons:

It is noted that of claims 30-41 rejected under 35 UCS 103 as being obvious over Ojjima in view of Parulski, claims 36-38 have been cancelled. Accordingly, the rejection of claims 36-38 is now moot, and the Applicant requests that the rejection of these claims (36-38) therefore be withdrawn.

It is further noted that, of remaining claims 30-35 and 39-41, claims 30, 35 and 41 are independent claims. Accordingly, if the Applicant can demonstrate that independent claims 30, 35 and 41 are allowable, then it follows that any claims which depend from these independent claims should also be allowable. Therefore, in the arguments presented below, the Applicant intends to focus primarily on the allowability of independent claims 30, 35 and 41. However, the failure on the part of the Applicant to present specific arguments with respect to any of the independent claims at this time should not be viewed as acquiescence on the part of the Applicant that the dependent claims are allowable solely based on their dependence from an allowable base claim, and the Applicant reserves the right to argue in the future for the separate allowability of the independent claims based upon their own merits.

Additionally, the Applicant reminds the Examiner of the standards, as set forth in MPEP 2142, for supporting a rejection of a claim under 35 USC 103. Specifically:

“[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there

must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations.** (Emphasis added.)

That said, the Applicant contends that each of independent claims 30, 35 and 41 are not obvious in view of the cited references, for at least the following reasons:

Claim 30:

Claim 30 has been amended to now recited (in relevant part):

a magnification control, including a zoom-in switch, accessible by a user of the digital camera to thereby allow the user to controllably magnify the acquired image and thereby produce a magnified representation of the acquired image;

a position control, including an up switch, a down switch, a left switch, and a right switch, and accessible by a user of the digital camera **to thereby allow the user to pan across, and controllably select, an area of the magnified representation of the acquired image;**

logic configured to provide a bounding box to identify the selected area of the magnified representation of the acquired image;

(Emphasis added.)

As can be seen, amended claim 30 requires that the “position control” allow a user to **“pan across, and controllably select, an area of the magnified representation of the acquired image.”**

This limitation is in complete contrast to the teachings of Ojima. (See, for example, ¶¶ [0045] – [0047] of Ojima.) Specifically, at paragraph [0047], Ojima states, “In other words, CPU 30 zooms the marked area to the display screen by the digital zoom process.” (Emphasis added.) This is also clearly shown in Figs. 3(a) – 3(d) of Ojima. In Figs. 3(a) and 3(b), an area is marked, and then in Figs. 3(c) and 3(d) the marked area is zoomed-in on to fill the screen. That is, Ojima teaches, “mark, then zoom”, which is just the opposite of “select ... an area of the magnified representation of the acquired image” (i.e., select an area of a zoomed image), as is required by Applicant’s claim 30.

Therefore, not only does Ojima not teach a limitation required by claim 30, but Ojima actually teaches away from claim 30.

Further, Parulski does not cure the deficiency of Ojima since, as stated by the Examiner (page 8 of OA):

Parulski is **only** cited for the teaching that it is desirable to allow the user to transfer images to external devices, the means to do so, and the teaching that the user should be able to select to transfer such selected portion (e.g. when and what to print).

(Emphasis in original.)

The Applicant Further contends that Parulski does not teach the “transfer control” of Applicant’s claim 1. As indicated in the Abstract of Parulski, and in Fig. 5 and the accompanying written description, the image transfer button of Parulski is on a digital printer, not on the digital camera. This is in contrast to Applicant’s claim 30, which recites (in relevant part), “A digital camera, comprising ... a transfer control, accessible by the user, to enable the user to transfer digital images from the digital camera to an external device communicatively coupled to the digital camera” Accordingly, Parulski actually teaches away from Applicant’s claim 30, since Parulski shows that the image transfer control is located on a printer, and not on the digital camera itself.

Claims 35 and 41:

Claim 35 (as amended), now includes the following limitations:

using a magnification control to controllably magnify the acquired image and thereby produce a magnified representation of the acquired image;

thereafter, using a position control provided with the digital camera, the position control including an up switch, a down switch, a left switch, and a right switch, to controllably select an area of the magnified representation of the acquired image on the image display;

(Emphasis added.)

Claim 41 (as amended), now includes the following limitations:

magnifying the acquired image to generate a magnified image, and displaying a portion of the magnified image on the image display;

thereafter, using a position control provided with the digital camera, the position control including an up switch, a down switch, a left switch, and a right switch, to pan over the magnified image, and re-displaying portions of the magnified image on the image display responsive to the panning;

(Emphasis added.)

As can be seen, in each of claims 35 and 41 the area selection is performed after the magnified image is displayed. As discussed above with respect to claim 30, this is in contrast to Ojima, wherein the area selection is performed before the image is magnified (zoomed-in on).

Likewise, with respect to claim 30, Parulski does not cure the deficiency of Ojima with respect to claims 35 and 41.

Accordingly, since the references do not teach "all the claimed limitations", as required by MPEP 2142, there is no way that independent claims 30, 35 and 41 (or any claims which depend therefrom) can be obvious over Ojima in view of Parulski. The Applicant therefore requests that the rejection of claims 30-35 and 39-41 be removed and the claims allowed.

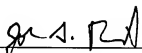
SUMMARY

In light of the foregoing amendments, and for at least the reasons set forth above, the Applicant respectfully submits that claims 30-35 and 39-41 should be allowed. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (509) 534-5789.

Respectfully submitted,

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